

Response to Final Office Action
Docket No. D/A0835**REMARKS**

Claims 1-29 are pending. Claims 1, 2, 7, 8, 13, 14, 19, and 23-27 have been amended. No new matter has been introduced. Claims 1-29 remain in the application.

5 Claims 26 and 27 stand rejected under 35 U.S.C. 112, second paragraph, for lack of antecedent basis. Claims 26 and 27 have been amended. Withdrawal of the objection is respectfully requested.

10 Claims 1-29 again stand rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 6,101,532, issued to Horibe et al. ("Horibe"). A *prima facie* case of obviousness requires: (1) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings; (2) a reasonable expectation of success; and (3) that the combined references teach or suggest all the claim limitations. *See, e.g.*, MPEP §§ 706.02(j), 2143. Applicant 15 traverses the rejection.

Horibe discloses an electronic conference system for a plurality of user clients, which includes a message database, message relation extracting unit, message type setting unit, message input and display unit, and electronic conference summarizing system (FIG. 1; Abstract; Col. 4, lines 15-22). A 20 conference participant, through a user client, can input a message to the message input and display unit and the message is stored as message data into the message database (Col. 2, lines 40-55; Col. 4, lines 30-34). By requesting or instructing the message input and display unit, a user client can freely refer to messages of other persons and can input a message, which responds to the messages of other 25 persons (Col. 4, lines 36-41). In response to the message from the user client, the message type setting unit allows a message type to be displayed by the user client through the message input and display unit and sets the message type for the message (Col. 4, lines 47-52; Col. 5, lines 31-35). The kinds of message types and the number thereof are previously defined to classify message contents (Col. 30 2, lines 30-40; Col. 4, lines 42-43). The message relation extracting unit

Response to Final Office Action
Docket No. D/A0835

discriminates a corresponding relationship between a reply message and a reply target message and allows the corresponding relationship to be held as a tree structure in the message database (Col. 4, lines 53-59). The message data is stored in a message record and a doubly-linked message relation list is formed as 5 a node for each message (Col. 5, line 60-Col. 6, line 49). The tree structure can be displayed by using the client user in response to a request of the conference participant (Col. 7, lines 44-58).

Thus, Horibe teaches an electronic conference system in which users can post messages through a plurality of user clients connected through a network and 10 in which users can refer to posted messages. Users can input messages through a user client and the user selects one of a plurality of previously defined message types to classify the message contents. Messages are formed into message relation lists and each message with a message relation list is a node that includes backward and forward pointers to trace corresponding parent and reply messages. 15 The message relation lists form discussion trees, which can be displayed in response to a request by the user.

In contrast, independent Claim 1 recites an electronic message composition device that detects that a new electronic message is being composed by a user; a related message determination device that, while the new electronic 20 message is being composed and prior to completion, *non-interactively* collects information pertaining to the new electronic message as message composition progresses and *continuously* determines whether one or more electronic messages are related to the new electronic message based on the collected information; . . . and a message display device that nondisruptively and automatically displays a 25 portion of the one or more related electronic messages *without requiring user action to request the display* (emphasis added). No new matter has been entered. Support for the claim amendments can be found in the specification on page 3, line 17-page 4, line 3 and lines 26-30; page 6, lines 7-21; page 7, line 31-page 8, line 22 and in FIGURES 1 and 3.

30 In contrast, independent Claim 7 recites detecting that a new electronic

Response to Final Office Action
Docket No. D/A0835

message is being composed by a user; while the new electronic message is being composed and prior to completion, *non-interactively* collecting information pertaining to the new electronic message as message composition progresses and *continuously* determining whether one or more electronic messages are related to

- 5 the new electronic message based on the collected information; . . . and nondisruptively and automatically displaying a portion of the one or more related electronic messages *without requiring user action to request the display* (emphasis added). No new matter has been entered. Support for the claim amendments can be found in the specification on page 3, line 17-page 4, line 3
- 10 and lines 26-30; page 6, lines 7-21; page 7, line 31-page 8, line 22 and in FIGURES 3 and 4.

In contrast, independent Claim 13 recites detecting that a new electronic message is being composed by a user; while the new electronic message is being composed and prior to completion, *non-interactively* collecting information

- 15 pertaining to the new electronic message as message composition progresses and *continuously* determining whether one or more electronic messages are related to the new electronic message based on the collected information; . . . and nondisruptively and automatically displaying a portion of the one or more related electronic messages *without requiring user action to request the display* (emphasis added). No new matter has been entered. Support for the claim amendments can be found in the specification on page 3, line 17-page 4, line 3
- 20 and lines 26-30; page 6, lines 7-21; page 7, line 31-page 8, line 22 and in FIGURES 3 and 4.

In contrast, independent Claim 19 recites a data system for *non-interactively* identifying data in electronic messages as message composition progresses, the data system adapted to *continuously* identify electronic messages related to a new electronic message based on the identified information while the new electronic message is being composed and prior to completion; . . . and an output device adapted to nondisruptively and automatically communicate the related electronic messages *without requiring user action to request the display*

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Response to Final Office Action
Docket No. D/A0835

(emphasis added). No new matter has been entered. Support for the claim amendments can be found in the specification on page 3, line 17-page 4, line 3 and lines 26-30; page 6, lines 7-21; page 7, line 31-page 8, line 22 and in FIGURES 1, 3 and 4.

5 A *prima facie* case of obviousness is not presented by Horibe. First, there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings of Horibe. Horibe teaches working with a message that has already been entered (“register’ . . . stores the input data 10 as message data into the message database,” Col. 5, lines 56-58). Horibe fails to suggest or provide a motivation to work with a message-in-progress. In addition, Horibe teaches a set of predefined message types, one of which must be selected by a user during message input. Relationships between parent and reply messages are expressly tracked in doubly-linked lists that are formed based on whether the 15 message being entered is being input by the user as a reply to a previous message. In contrast, Horibe fails to suggest or provide a motivation to select the message type for the user or to track message relationships independent from a relationship specified by the user.

Second, there is no reasonable expectation of success based on such 20 modification or combination. Messages can only be tracked by Horibe only after they have been stored into the message database and not before. As well, the predefined message types taught by Horibe are needed to classify message contents when messages in a discussion tree are displayed (See, e.g., FIG. 4). Absent message types, Horibe would only be able to provide literal message data, 25 such as message titles, that would enable a user to visually determine the message type. Similarly, the discussion trees taught by Horibe are based on the message relation lists. However, without the message relation lists, Horibe would fail to provide a way to track related messages, thereby only being able to display an unordered list of messages to the user.

30 Last, the combined references fail to teach or suggest all the claim

Response to Final Office Action
Docket No. D/A0835

limitations. Horibe fails to teach or suggest continuously determining related electronic messages while a new electronic message is being composed and prior to completion based on information that was non-interactively and progressively collected, per amended Claims 1, 7, 13, and 19. Thus, for instance, a user can add 5 or delete recipient addresses or may modify the Subject field and a new set of related electronic messages would automatically be determined based on the revised information. Horibe further fails to teach or suggest nondisruptively and automatically displaying the related electronic messages without requiring user action to request the display, per amended Claims 1, 7, 13, and 19. The action 10 that triggers the retrieval of the related electronic messages is the creation or editing of a new message, not an explicit request for related messages, following a link to previous messages, or pressing a "search" button. Furthermore, Horibe fails to teach or suggest determining related electronic messages based on non-interactively and progressively collected information, per amended Claims 1, 7, 15 13, and 19. Related electronic messages can include, for example, both messages from a conversational thread and messages that are sent to or from one or more recipients, whereas Horibe relies on explicit message threads.

Accordingly, a *prima facie* case of obviousness is not present for independent Claims 1, 7, 13, and 19. Claims 2-6 and 22-23 are dependent on 20 Claim 1 and are patentable for the above-stated reasons, and as further distinguished by the limitations therein. Claims 8-12 and 24-25 are dependent on Claim 7 and are patentable for the above-stated reasons, and as further distinguished by the limitations therein. Claims 14-18 and 26-27 are dependent on Claim 13 and are patentable for the above-stated reasons, and as further 25 distinguished by the limitations therein. Claims 20-21 and 28-29 are dependent on Claim 19 and are patentable for the above-stated reasons, and as further distinguished by the limitations therein. Withdrawal of rejection under 35 U.S.C. 103(a) is respectfully requested.

The prior art made of record and not relied upon has been reviewed by the 30 applicant and is considered to be no more pertinent than the prior art references

Response to Final Office Action
Docket No. D/A0835

already applied.

Claims 1-29 are believed to be in a condition for allowance. Examination and further consideration is respectfully requested. Entry of the claim amendments and withdrawal of the finality of the Office action are respectfully
5 requested. A Notice of Allowance is earnestly solicited. Please contact the undersigned at (206) 381-3900 regarding any questions or concerns associated with the present matter.

Respectfully submitted,

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Dated: November 25, 2005

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